

## **REMARKS**

The following remarks are provided in response to the Office Action dated November 18, 2004 in which the Examiner:

- rejected claims 1-4, 6-11, 13-14, 21-24, and 26-27 under 35 U.S.C. §103(a) as being unpatentable over United States Patent No. 6,480,853 to Jain in view of United States Patent No. 5,963,915 to Kirsch and in further view of United States Patent No. 5,933,822 to Braden-Harder et al. (hereinafter Braden-Harder).

The applicant respectfully requests reconsideration of the above referenced patent application in view of the amendments and remarks set forth herein, and respectfully requests that the Examiner withdraw all rejections.

### **35 U.S.C. §103(a)**

The Examiner rejected claims 1-4, 6-11, 13-14, 21-24, and 26-27 under §103(a) as being unpatentable over Jain in view of Kirsch and in further view of Braden-Harder. For at least the following reasons, the applicant respectfully asserts that he has overcome the Examiner's rejection and respectfully requests that the Examiner allow claims 1-4, 6-11, 13-14, 21-24, and 26-27.

A *prima facie* case of obviousness under 35 U.S.C. §103 requires, among other criteria, that ". . . the prior art reference (or references when combined) must teach or suggest all the claim limitations." (emphasis added) (See M.P.E.P. 706.02(j) and 2143.03). To overcome a §103(a) rejection, the applicant must only demonstrate that the cited prior art document or documents fail individually and in combination to teach or suggest one element or limitation present in the claim. Further, "[w]hen a reference is

complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated [by the Examiner] as nearly as practicable.”

(See M.P.E.P. §706 citing 37 C.F.R. §1.104(c)(2)).

Previously presented independent claim 1 recites in a salient portion:

generate a set of one or more common search requests for subsets of the product data **based on the frequency of previously received search requests and designation of a search request as a common search request;**  
perform the generated set of common search requests to identify one or more products;  
store on the server an indication of one or more products identified as a result of performing the set of common search requests;  
(emphasis added)

Independent claims 8 and 21 recite a similar limitation. The Examiner notes that neither Jain nor Kirsch specifically discloses generating a set of one or more common search requests based on the frequency of previously received search requests. The applicants agree. The Examiner instead alleges that Braden-Harder Figure 2 and column 2 line 34 bridging column 3 line 6, and column 8 line 30 bridging column 9 line 43 disclose generating a set of one or more common search requests based on the frequency of previously received search requests. The applicant respectfully disagrees. Braden-Harder column 2 line 34 bridging column 3 line 6 discloses statistical processing to reduce the number of irrelevant documents **retrieved** by a search:

For example, based on the total number of matching key words between those in the query and the content words of in each retrieved document record and how well those words match, i.e., in the combination and/or within a proximity range requested, a statistical search engine calculates numeric measures, collectively referred to as “statistics,” for each document record retrieved.

Further, “[t]hese statistics may include an inverse document frequency for each matching word.” (See Braden-Harder column 2 lines 45-46) According to Braden-Harder, the

retrieved documents can thereafter be ranked according to the statistics. More specifically, “the browser . . . scores each document having such a match and presents the user with those documents . . . ranked in terms of descending score, typically in a group of a predefined small number of documents having the highest rankings. . .” (See Braden-Harder column 9 lines 26-31). The applicant asserts that the cited portions of Braden-Harder describe a way of ranking documents that have already been retrieved according to the key words in the search query compared to content words in the document and that such ranking is performed by the browser. The word frequency statistic disclosed to rank the retrieved documents in no way includes the frequency of the search request that generated the retrieved documents. Said alternatively, there is no indication in the cited portions of Braden-Harder that the documents are searched and/or stored according to a common search request and that the common search request is *inter alia* based on the frequency of previously received search requests as recited by previously presented independent claim 1. In fact, Braden-Harden column 9 lines 2-8 recite that:

Inasmuch as the manner through which engine 225 actually indexes documents to form document records for storage in data store 227 and the actual analysis which the engine undertakes to select any such stored document record are both irrelevant to the present invention, we will not discuss either of these aspects in any further detail.  
(emphasis added)

The applicant confirms, therefore, that the cited portions of Braden-Harden discuss only a ranking performed on retrieved documents and explicitly exclude discussion of any search and/or storage that occurs prior to ranking the retrieved document.

Accordingly, the applicant respectfully asserts that previously presented independent claims 1, 8 and 21 recite at least an element not taught by Jain in view of

Kirsch and Braden-Harder and requests that the Examiner allow independent claims 1, 8, and 21. The applicant further affirms that dependent claims 2-4, 6-7, 9-11, 13-14, 22-24, and 26-27 are patentable as each depends from a nonobvious independent claim. (See M.P.E.P. §2143.03 (citing In re Fine, 5 U.S.P.Q.2d (BNA) 1596 (Fed. Cir. 1988))).

### CONCLUSION

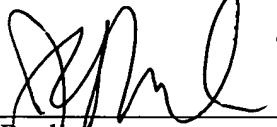
For at least the foregoing reasons, the applicant submits that he has overcome the Examiner's rejections and that he has the right to claim the invention as set forth in the listed claims. The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

Please charge any shortages and credit any overcharges to our Deposit Account number 02-2666.

Respectfully submitted,

BLAKELY SOKOLOFF TAYLOR & ZAFMAN, L.L.P.

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Dated

  
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